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RI-61182/RBC/VEJ
Application No. 09/375,164
Filed: August 16, 1999
Art Unit: 3727

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Brian M. Adams *et al.*

Application No. 09/375,164

Filed: August 16, 1999

For: **SPILL-REDUCTION CAP FOR
FLUID CONTAINER**

Art Unit: 3727

Examiner: **Stephen K. Cronin**

Docket No.: **RI-61182/RBC/VEJ**

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APPELLANT'S APPEAL BRIEF

PATENT

RI-61182/RBC/VEJ
Application No. 09/375,164
Filed: August 16, 1999
Art Unit: 3727

Appellant, through its undersigned counsel, hereby submits this Appeal Brief in triplicate in support of the Notice of Appeal filed October 31, 2000.

An After Final Amendment is submitted herewith. The After Final Amendment does not raise new issues and presents the rejected claims in better form for consideration on appeal.

Enclosed is a check in the amount of \$320.00 to cover the Appeal Brief filing fee.

Also enclosed is a check in the amount of \$920.00 to cover the fee for a two-month extension of time extending the period for filing the Appeal Brief from December 31, 2001 to March 31, 2002. Since March 31, 2002 was a Sunday, this is being timely filed on the next business day, Monday, April 1, 2002.

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PATENT

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APPEAL BRIEF

1.0 Real Party in Interest

The real party in interest is the assignee, Portola Packaging, Inc., a Delaware corporation, as evidenced by an Assignment recorded in the U.S. Patent and Trademark Office on July 7, 1995 at Reel/Frame 7671/0197.

2.0 Related Appeals and Interferences

There are no related appeals or interferences.

3.0 Status of Claims

This is an appeal from the final Office Action dated August 1, 2001. Claims 1-28 are pending. Claims 1-28 are the subject of this appeal. Claims 1-28 stand rejected by the Examiner. No claim has been allowed by the Examiner.

Appellant respectfully notes that claims 17, 18 and 21-28 have not been rejected as anticipated nor obvious over the prior art of record.

4.0 Status of Amendments

An After Final Amendment is submitted herewith. The After Final Amendment does not raise new issues and presents the rejected claims in better form for consideration on appeal. As

the After Final Amendment is submitted herewith, it has not yet been acted upon by the Examiner.

The After Final Amendment includes: 1.) a declaration as to loss or inaccessibility of the original patent; 2.) a supplemental reissue declaration made by the inventors; and 3.) a terminal disclaimer.

5.0 Summary of Invention

The present invention is directed to a plastic push-on type cap particularly suited for use with large water bottles of the type which are generally inverted and used with a conventional water dispenser. An important feature of the present caps is the elimination of spillage when the bottle is installed in a conventional water dispenser as well as a considerable reduction in spillage of any water which may remain in the bottle when the bottle is removed from the dispenser. To this end, the present cap includes a well formed in the top of the cap and the well is provided with a scoreline. The cap splits along the scoreline when the bottle is installed in the dispenser, thus allowing access to the water in the bottle. As the cap is formed of a resilient plastic, split portions of the well come together as the bottle is removed from the dispenser thereby inhibiting leakage of any water remaining in the bottle.

In the disclosed embodiments, the well has a rounded bottom. The scoreline in the well includes three continuous sections, namely, a first section extending downwardly along one portion of the conical side of the well, a second section extending across the rounded bottom of

well, and a third section extending from the second section up another portion of the conical side of the cap, all three sections lying in a common diametric plane.

The cap of the present invention is primarily designed for use with a conventional water dispenser that has a blunt-tipped probe extending vertically upward. As a bottle equipped with the cap of the present invention is lowered onto the water dispenser, the probe engages the well and causes the well to split along the scoreline. Thus, once the bottle is fully installed on the water dispenser, the probe extends through the cap thus permitting water to flow from the bottle through the probe and then to the water dispenser.

In use, the tip of the probe first contacts the center of the rounded bottom of the well and initiates tearing the well apart at the scoreline. One should appreciate that the cap is formed of a thin, resilient plastic material and that tearing is not strictly limited to the scoreline. Instead, the scoreline facilitates tearing and directs tearing along a particular path.

When the user removes the bottle from the water dispenser, the probe is withdrawn from the well. As noted above, the cap is formed of a resilient plastic and withdrawal of the probe from the well allows the well to close, at least partially, that is, spring back to its original position thereby reducing the size of the split opening and reducing the amount of water which may flow out of the bottle through the split opening while the bottle is being removed from the water dispenser and restored to an upright position.

6.0 Issues

The following are the issues presented on appeal:

6.1 Whether claims 1-28 incorporate new matter under 35 U.S.C. § 251, namely, whether the limitation “at least one scoreline positioned on said bottom” in each of independent claims 1 and 26 encompasses new matter;

6.2 Whether claims 1-28 contain subject matter under 35 U.S.C. § 112, first paragraph, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention.

6.3 Whether claims 1-25 sufficiently claim the structure of the central well of the cap in accordance with 35 U.S.C. § 112, second paragraph, such that only a probe with a blunt tip will engage the bottom at a center thereof;

6.4 Whether claims 1-26 set forth the subject matter which Appellant regards as the invention in accordance with 35 U.S.C. § 112, second paragraph, namely, whether claims 1-26 correspond in scope with that which Appellant regards as the invention; and

6.5 Whether claims 1, 2, 5, 9, 15 and 16 are anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,022,258 to Steidley (hereinafter “Steidley”).

7.0 Grouping of Claims

7.1 With respect to the rejection of claims 1-28 under 35 U.S.C. § 251, claims 1-28 stand or fall together.

7.2 With respect to the rejection of claims 1-28 under 35 U.S.C. § 112, first paragraph, claims 1-28 stand or fall together.

7.3 With respect to the rejection of claims 1-25 under 35 U.S.C. § 112, second paragraph, claims 1-25 stand or fall together.

7.4 With respect to the rejection of claims 1-26 under 35 U.S.C. § 112, second paragraph, claims 1-26 stand or fall together, and claim 26 stands or falls alone.

7.5 With respect to the rejection of claims 1, 2, 5, 9, 15 and 16 under 35 U.S.C. § 102(b), claims 1, 9 and 16 stand and fall together, claim 2 stands and falls alone, claim 5 stands and falls alone, and claim 15 stands and falls alone.

8.0 Argument

8.1 Background

This application is a broadening reissue application of U.S. Patent No. 5,687,865 (hereinafter "the original patent"). Patentee Appellant believed the original patent to be inoperative or invalid by reason of claiming more or less than the patentee had a right to claim. In particular, Appellant believed that they had a right to broadly claim a cap having a well and a scoreline positioned on the bottom of the well as opposed to claiming a cap having a well and a scoreline which extended down a portion of the side wall, across the bottom and up another portion of the side wall.

Appellant further used the broadening reissue application as an opportunity to correct and/or clarify various other minor informalities and errors of the original patent. Although the

scope of the issued claims covered one or more scorelines, Appellant desired to clarify this point by way of inserting the “at least one” terminology which is found in the presently amended claims.

8.2 35 U.S.C. § 251 Rejection of Claims 1-28

The Examiner has rejected claims 1-28 under 35 U.S.C. § 251 as being based upon new matter added to the patent for which reissue is sought. The Examiner bases the rejection on the premise that the original patent provides support for only one scoreline extending down one portion of the side wall, across the bottom, and up another portion of the side wall. In particular, the Examiner has taken the position that the original patent does not provide support for either 1.) a plurality of scorelines or 2.) a scoreline positioned only on said bottom. The Examiner considers the limitation “at least one” and the limitation “positioned on the bottom” as new matter.

8.2.1 “At Least One”

As noted in Appellant’s previous AMENDMENT AND REPLY UNDER 37 C.F.R. § 1.173 dated April 27, 2001, one difference between the new claims and the corresponding original claims of the original patent is that the new claims call for a cap having “at least one scoreline”. *See, e.g.*, claim 1, line 8; claim 26, line 9. The Examiner’s position is that original patent does not provide support for a plurality of scorelines. *See* Office Action dated August 31, 2001, page 4, last line, through page 5, line 1. Although the Examiner correctly considers the

presently amended claims to read on caps having a plurality of scorelines in addition to caps having just one scoreline, Appellant respectfully submit that the Examiner improperly considers the issued claims of the original patent to read only on caps having just one scoreline. *See* original patent, claim 1, column 6, line 22. In particular, Appellant respectfully submits that the Examiner improperly bases the rejection on the premise that the specification fails to teach any option of providing more than one scoreline, namely, that “[n]o other alternatives to this invention/preferred embodiment are taught.” *See* Office Action dated August 1, 2001, page 7.

Appellant respectfully submits that the “a scoreline” limitation found in the claims of original patent does not preclude a plurality of scorelines but instead encompasses one or more scorelines. The Federal Circuit “has repeatedly emphasized that an indefinite article ‘a’ or ‘an’ in patent parlance carries the meaning of ‘one or more’ in open-ended claims containing the transitional phrase ‘comprising.’” *See, e.g., KCJ Corp. v. Kinetic Concepts, Inc.* 55 USPQ2d 1835, 1838-40 (Fed. Cir. 2000)(*citations omitted*). In accordance with the general rule acknowledged by the Federal Circuit, the claim limitation “a scoreline” found in the claims of original patent encompasses one or more scorelines. *Id.* Thus, the limitation “a scoreline” can also be interpreted as “at least one scoreline”. *See KCJ Corp.*, 55 USPQ2d at 1839 (“Under this conventional rule, the claim limitation ‘a,’ without more, requires *at least one*.” (*emphasis added*)). The terminology “at least one” added to claim 1 during prosecution of the present application merely explicitly states that the scope of the claims encompasses a cap having, *inter alia*, one or more scorelines, a feature which, is already encompassed by the scope of issued

claim 1 of the original patent according to the general rule followed by the Federal Circuit. *KCJ Corp.*, 55 USPQ2d at 1839.

Appellant further submits that the claims cannot be limited to a single scoreline because the claim language of the original patent are not limited to a single scoreline. See *Karlin Tech., Inc. v. Surgical Dynamics, Inc.*, 50 USPQ2d 1465, 1469 (Fed. Cir. 1999). Instead, the general rule is that the claims of a patent are not limited to the preferred embodiment, unless by the claims are limited by their own language. See *Karlin Tech.*, 50 USPQ2d at 1469 (citing *Virginia Panel Corp. v. Mac Panel Co.*, 45 USPQ2d 1225, 1229 (Fed. Cir. 1997)) (“[I]t is well settled that device claims are not limited to devices which operate precisely as the embodiments described in detail in the patent.”)). In the present case, the claims of the original patent utilize the indefinite article ‘a’ to recite “a scoreline”. See original patent, claim 1, column 6, line 22. Contrary to the Examiner’s position, the original claims are not limited to “one” scoreline because the original claims do not recite “one” scoreline. See *Karlin Tech.*, 50 USPQ2d at 1469.

Appellants further submit that the disclosure of a preferred or exemplary embodiment encompassing a singular element does not disclaim a plural embodiment. *KCJ Corp.*, 55 USPQ2d at 1839 (“[S]tanding alone, a disclosure of a preferred or exemplary embodiment encompassing a singular element does not disclaim a plural embodiment.”). The disclosure of a preferred or exemplary embodiment encompassing a singular scoreline does not disclaim a cap having a plurality of scorelines. *KCJ Corp.*, 55 USPQ2d at 1839. Simply put, Appellant is not limited to a single scoreline because the preferred embodiments of the invention disclosed have a single scoreline. See *Ex parte Cassel*, 82 USPQ 108, 110 (Bd. Pat. App. & Int., 1949) (“There is

no question that applicant has a disclosure of using one elastomer and under the circumstances of this case, we see no objection to [using 'at least one elastomer'] . . . even though application has no disclosure of using more than one elastomer.”).

For at least these reasons, Appellant respectfully submits that the “at least one” terminology of claims 1-28 does not contain new matter as the terminology merely explicitly recites a feature in the pending claims which would have been present in the claims of the original patent in accordance with long recognized and widely followed by general rules. For at least these reasons, Appellant respectfully requests that the Board overturn and withdraw the Examiner’s rejection of claims 1-28 under 35 U.S.C. §251.

8.2.2 “Positioned on the Bottom”

As noted in Appellant’s previous AMENDMENT AND REPLY UNDER 37 C.F.R. § 1.173 dated April 27, 2001, another difference between the new claims and the corresponding original claims of original patent is that the new claims call for a cap having at least one scoreline “positioned on [the] bottom” of a well of the cap. *See, e.g.*, claim 1, lines 8-9. The Examiner has taken the position that the prior patent does not provide support for a scoreline positioned only on said bottom. *See* Office Action dated August 31, 2001, page 4, lines 1-2. In this regard, Examiner notes that the specification, that is, the disclosed preferred embodiment thereof teaches that the scoreline comprises three stretches. *See* Office Action, page 8, lines 2-6.

As discussed above, Appellant respectfully submits that it is a general rule that the claims of a patent are not limited to the preferred embodiment disclosed in the specification. *See, e.g.*,

Elkay Manufacturing Co. v. Ebco Manufacturing Co., 52 USPQ2d 1109, 1112 (Fed. Cir. 1999); *Karlin Tech., Inc.*, 50 USPQ2d at 1469 (Fed. Cir. 1999). In fact, it has long been held that inventors are not required to limit their claims to a specific example or examples disclosed in their application but are entitled to claim their invention as broadly as the prior art permits. *Beale v. Schuman*, 212 USPQ 291, 293-94 (Bd. Pat. App. & Int. 1980) (“[A]n appellant in a mechanical case is allowed claims, when the art permits, which cover more than the specific embodiments shown.”)(citing *In re Moore*, 169 U.S.P.Q. 236 (C.C.P.A. 1971)).

In the present application, Appellant respectfully submits that the first stretch 52 and the third upward stretch 54 described in the patent specification are only part of an embodiment of the invention and are not *necessary* for the insertion of probe 61 through scoreline 51. *See, e.g.*, FIG. 3. The cap of the present invention is designed for use with a conventional water dispenser which includes a upwardly extending probe 61 so that when a bottle equipped with cap 21 of the present invention is lowered onto the water dispenser, probe 61 engages well 46 and causes well 46 to split along scoreline 51. *See* original patent, column 2, lines 59-64; column 4, lines 62-68. Generally, the tip of the probe first contacts the center of the rounded bottom of the well and initiates tearing the well apart at the scoreline. *Id.*

The cap of the present invention is formed of a resilient plastic. *See* original patent, column 2, lines 7-9; claim 5. Accordingly, Appellant submits that one of ordinary skill in the art would recognize that as the probe causes the well to split along the scoreline, tearing would not be strictly limited to the scoreline. Instead, one would recognize that the scoreline facilitates tearing and directs tearing along a particular path. Appellant respectfully submits that a scoreline

positioned on the bottom would function in the same manner as the disclosed embodiment and achieve the same result, namely, a scoreline on the bottom would also allow the well to split apart as the probe of a water dispenser engages the well. Thus, Appellant is entitled not only to claims directed to caps having a scoreline extending along a side wall and across the bottom of the well, but are also entitled to claims directed to caps that have a scoreline positioned on a bottom of the well of the cap, unless of course, the prior art prevents such claims. *Beale*, 212 USPQ at 294. Accordingly, Appellant submits the limitation "one scoreline positioned on said bottom" is not new matter.

Nonetheless, what particularly bothers the Examiner is that the new claims *also* read on a cap having a scoreline positioned *only* the bottom. *See* Office Action of August 1, 2001, page 8, first paragraph. Although an embodiment having three stretches was disclosed as the preferred embodiment and the specification does not expressly include other embodiments, the specification does not preclude other embodiments that have not been expressly disclosed. *See Ex parte Froeschle and Schreiber*, 223 USPQ 190, 191 (Bd. Pat. App. & Int., 1984). In the present case, the specification of the original patent does not expressly preclude a cap having a scoreline positioned only on the bottom. Thus, Appellant is not precluded from claiming a cap in which only a portion of the disclosed scoreline is claimed, that is, a scoreline positioned only on the bottom. *Ex parte Froeschle*, 223 USPQ at 191 (applicant entitled to direct claims in a reissue application to one or more loudspeaker drivers although review of disclosure reveals a multiple drive system is preferred: disclosure neither expressly includes nor precludes single driver systems). In fact, Appellant is entitled to claim their invention as broadly as the prior art permits.

See Beale, 212 U.S.P.Q. at 293-94. Appellant are not required to limit their claims to a specific example or examples disclosed in the specification of the original patent. *See Beale*, 212 U.S.P.Q. at 293-94.

The fact that the present claims may read not only the disclosed scoreline but also on scorelines that are positioned on the bottom of the well is not precluded by the requirements of 35 U.S.C. § 112, first paragraph. *Beale*, 212 U.S.P.Q. at 293. In a mechanical case, broad claims may be supported by a specific embodiment and an inventor need not limit his claims to precisely what he has found will work. *Beale*, 212 U.S.P.Q. at 293. As the Federal Circuit has acknowledged, the fact that the present claims may be broader than the specific embodiment disclosed in the specification is in itself no moment. *See In re Peters and Anderson*, 221 USPQ 952, 953 (Fed. Cir. 1983). "Indeed, the statutory provision for broadened claims in reissue applications is intended to meet precisely the situation in which a patentee has claimed 'less' than he had a right to claim." *Peters*, 221 USPQ at 953 (*quoting In re Rasmussen*, 211 USPQ 323, 326 (CCPA 1981)(*citing* 35 U.S.C. § 251)).

In the present case, Appellant is entitled under 35 U.S.C. § 251 to claims that would encompass scorelines which are, in essence, differently shaped than that which is disclosed and described in the specification. *Peters*, 221 USPQ at 953. Appellant respectfully submits that the overall disclosure reasonably conveys to one skilled in the art that the inventors had possession of the broad invention at the time the original application. *Peters*, 221 USPQ at 954 (*citations omitted*). In particular, Appellant respectfully submits that the overall disclosure reasonably conveys to one skilled in the art that the inventors had possession of a plastic cap having a

scoreline in a well which splits apart as a blunt-tipped probe of a water dispenser engages the bottom of a well and splits the bottom of the well along the scoreline in the same manner as which is shown in FIG. 5.

Furthermore, Appellant agrees with the Examiner insofar as an applicant has every right to claim his invention as broadly as is patentably allowed. *See* Office Action of August 1, 2001, page 7, last paragraph. However, in contrast to the Examiner's position, Appellant respectfully submits that the present claims *do not* "specifically set forth alternative embodiments which are not disclosed". *See id.* Instead, the presently pending independent claims are generic so as to read upon the disclosed embodiment as well as other undisclosed embodiments. In particular, the disclosed embodiment undoubtedly includes a scoreline 51 positioned on the bottom of well 46. *See* FIGS. 2 and 3. The mere fact that the claims may read upon other embodiments in addition to the disclosed embodiment simply does not support the Examiner's position. Instead, Appellant respectfully submits that claiming only a scoreline on the bottom of the well is not new matter because the original patent *discloses* a scoreline on the bottom of the well. *See* original patent, FIG. 3.

For at least these reasons, Appellant respectfully submits that the "one scoreline positioned on said bottom" terminology of claims 1-28 does not contain new matter. Appellant respectfully requests that the Board overturn and withdraw the Examiner's rejection of claims 1-28 under 35 U.S.C. §251.

8.3 35 U.S.C. § 112, first paragraph, Rejection of Claims 1-28

The Examiner has rejected claims 1-28 under 35 U.S.C. § 112, first paragraph, as being based upon new matter added to the patent for which reissue is sought. The Examiner bases this rejection on the same premise upon which the Examiner rejected claims 1-28 under 35 U.S.C. § 251. Namely, the Examiner considers the original patent to provide support for only one scoreline extending along the side wall and across the bottom.

Appellant respectfully submits that the “one scoreline positioned on said bottom” terminology of claims 1-28 does not contain new matter with regard to 35 U.S.C. §112, first paragraph, for the same reasons the terminology does not contain new matter with regard to 35 U.S.C. §251, as is discussed in detail above. The Federal Circuit has acknowledged “that the inquiry under § 251 as to whether the new claims are for the invention originally disclosed is analogous to the analysis required by § 112 ¶ 1.” *In re Amos*, 21 USPQ2d 1271, 1275 (Fed. Cir. 1991)(*citations omitted*).

Accordingly, and for the sake of brevity, Appellant respectfully submits that the “one scoreline positioned on said bottom” terminology of claims 1-28 does not contain new matter under 35 U.S.C. §112, first paragraph, for the same reasons that the terminology does not contain new matter under 35 U.S.C. §251 as discussed above. Appellant respectfully requests that the Board overturn and withdraw the Examiner’s rejection of claims 1-28 under 35 U.S.C. §112, first paragraph, for the same reasons that Appellant respectfully requests the Board of Appeals to overturn and withdraw the Examiner’s new matter rejection under 35 U.S.C. §251 discussed above.

8.4 35 U.S.C. § 112, second paragraph, Rejection of Claims 1-25

The Examiner has rejected claims 1-25 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner has taken the position that, applicant has failed to sufficiently claim the structure of the center well of the cap such that only a probe with a blunt tip will engage the bottom center thereof. *See* Office Action of August 1, 2001, page 5, section 9, third paragraph. The Examiner sets forth no further explanation with regard to this rejection.

Appellant respectfully submits that the Examiner's rejection is improper because the Examiner has failed to consider the claim as a whole. *See* MPEP § 2173.02, page 2100-194 (8th ed. 2001). The MPEP requires the examiner to consider a claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope. *Id. (citations omitted)*. Claims 1-25 are not merely directed to the structure of a central well of a cap such that *only* a probe with a blunt tip will engage the bottom at a center thereof. *See* Office Action of August 1, 2001, page 5, section 9, third paragraph. Instead, claims 1-25 are directed to a cap including:

a top . . . being formed with a central well having a side wall and a bottom; at least one scoreline positioned on said bottom, said side wall formed to cause a probe having a blunt tip to engage said bottom at a center thereof as the probe is forced into said well, said at least one scoreline positioned such that the blunt tip splits said bottom along said scoreline as the blunt tip of the probe is forced against said center of said bottom so that said probe may enter said neck.

See claim 1. Appellant respectfully submits that claim 1, and claims 2-25 dependent thereon, meet the threshold requirements of clarity and precision which are required by 35 U.S.C. § 112, second paragraph. In particular, one of ordinary skill in the art would understand the scope of

claim 1, and its dependent claims, namely, as directed to a cap having a scoreline in a well which is designed to split apart when a blunt tipped probe is inserted into the well.

Appellant respectfully submits that the functional limitations of claim 1 provide a claim which particularly points out and distinctly claims the subject matter which Appellant regards has their invention for the purposes of 35 U.S.C. § 112, second paragraph. As claim 1 has been drafted in such a manner to define a portion of the well by what it does rather than what it is, Appellants respectfully submit that it is unnecessary to define the structure of the central well. Appellant further submits that there is nothing wrong with defining some parts of the cap in functional terms instead of structural terms. *See* MPEP § 2173.05(g), page 2100-201 (8th ed. 2001).

For at least these reasons, Appellant respectfully submits that claim 1, and claims 2-25 dependent thereon, particularly point out and distinctly claim a cap having a scoreline in a well which is designed to split apart when a blunt tipped probe is inserted into the well. Appellant respectfully requests that the Board overturn and withdraw the Examiner's rejection of claims 1-25 under 35 U.S.C. § 112, second paragraph.

8.5 35 U.S.C. § 112, second paragraph, Rejection of Claims 1-26

8.5.2 Claims 1-25

The Examiner has rejected claims 1-25 under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicant regards as the invention. In particular, the Examiner has taken the position that the invention is different than what is defined in the claims

because the Amendment and Reply dated April 27, 2001 (received by the U.S. Patent and Trademark Office on April 30, 2001) argued that U.S. Patent No. 4,022,258 to Steidley ("the Steidley patent") does not anticipate the claimed invention. The Examiner premises his rejection on the assumption that the claimed side wall of the well is identical to closure disclosed by the Steidley patent. Appellant disagrees.

Firstly, claims 1-25 are not directed solely to a side wall. Instead, the claims are directed to a cap which includes, *inter alia*,

a top . . . being formed with a central well having a side wall and a bottom, at least one scoreline positioned on said bottom, said side wall formed to cause a probe having a blunt tip to engage said bottom at a center thereof as the probe is forced into said well, said at least one scoreline positioned such that the blunt tip splits said bottom along said scoreline as the blunt tip of the probe is forced against said center of said bottom so that said probe may enter said neck.

See claim 1. As Appellant noted in the Amendment and Reply dated April 27, 2001 (received by the U.S. Patent and Trademark Office on April 30, 2001), "[t]he Steidley patent does not disclose a cap including a well having a scoreline which is split by a probe having a blunt tip nor does the Steidley patent disclose, teach or suggest a side wall formed to cause such a probe to engage a center portion of a bottom of the well." *See* Amendment and Reply dated April 27, 2001, page 12, second whole paragraph.

In contrast, the Steidley patent discloses a closure 10 having a tubular sleeve 14 extending downwardly from a top wall 13 and a bottom wall 15 closing the lower end of sleeve 14. The closure, and in particular, bottom wall 15 is formed to allow a piercing spike 23 to cut bottom wall 15. *See* column 2, lines 20-22; column 4, lines 17 *et seq.* In particular, piercing

spike 23 cuts bottom wall about almost the periphery of bottom wall 15. *See* column 5, lines 12-31. Since a cutting edge 25 of spike 23 is interrupted at a heel portion 27, piercing spike 23 forms a flap 36 which folds downwardly to make way for the descending spike. *Id.*

The Steidley patent does not disclose a scoreline on a bottom wall. Nor does the Steidley patent require a scoreline because the path of slicing need not be facilitated by the structure of closure 10. Instead, the shape of cutting edge 25 dictates the direction and path along which bottom wall 15 is cut by the piercing spike 23. The closure of the Steidley patent is not designed to be used with a blunt probe, it is designed to be used with a sharpened spike having a cutting edge.

Furthermore, Appellant simply does not understand how the Examiner arrives at his conclusion that the structure disclosed by the Steidley patent is identical to the structure of the claimed side wall when the present claims do not even define the specific structure of the side wall. *See* claim 1, lines 9-12. Instead, claim 1 has been drafted in such a manner to define the side wall of the cap by what it does rather than what it is. As noted above, the Steidley patent does not disclose a cap including a well having a scoreline which is split by a probe having a blunt tip nor does the Steidley patent disclose, teach or suggest a side wall formed to cause a blunt tipped probe to engage a center portion of a bottom of the well.

For at least these reasons, Appellant respectfully submits that claim 1, and claims 2-25 dependent thereon, correspond in scope with that which Appellant regards as the invention, namely, a cap having a scoreline in a well which is designed to split apart when a blunt tipped

probe is inserted into the well. Appellant respectfully requests that the Board overturn and withdraw the Examiner's rejection of claims 1-25 under 35 U.S.C. § 112, second paragraph.

8.5.2 Claim 26

The Examiner has rejected Claim 26 under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicant regards as the invention. In particular, the Examiner has taken the position that the invention is different than what is defined in the claims because the Amendment and Reply dated April 27, 2001 (received by the U.S. Patent and Trademark Office on April 30, 2001) argued that U.S. Patent No. 4,022,258 to Steidley ("the Steidley patent") does not anticipate the claimed invention. The Examiner premises his rejection on the assumption that the claimed side wall of the well is identical to closure disclosed by the Steidley patent. Appellant respectfully submits that the actual structure of the side wall is irrelevant to the patentability of claim 26. Instead, claim 26 calls for, *in combination*:

a hollow, apertured *probe having a blunt tip*, a cap, a container having a neck having external means for detachably engaging said cap, said cap being shaped to fit over said neck and comprising

a top and a skirt depending from said top internal means on said skirt to engage said external means to hold said cap on said neck, said top being formed with a central wall having a side wall and a bottom, at least one scoreline positioned on said bottom,

said blunt tip engagable with said bottom to split said scoreline so said probe may enter said container (*emphasis added*).

The Steidley patent discloses a closure 10 having a tubular sleeve 14 extending downwardly from a top wall 13 and a bottom wall 15 closing the lower end of sleeve 14. The closure, and in particular, bottom wall 15 is formed to allow a piercing spike 23 to cut bottom

wall 15. *See* column 2, lines 20-22; column 4, lines 17 *et seq.* In particular, piercing spike 23 cuts bottom wall about almost the periphery of bottom wall 15. *See* column 5, lines 12-31. Since a cutting edge 25 of spike 23 is interrupted at a heel portion 27, piercing spike 23 forms a flap 36 which folds downwardly to make way for the descending spike. *Id.*

Although the Steidley patent discloses that bottom wall is relatively thin, especially along its annular outer portion 15a, *see* column 3, lines 48-52, the Steidley patent does not disclose a scoreline on bottom wall 15. Nor does the Steidley patent require a scoreline because the path of slicing need not be facilitated by the structure of closure 10. Instead, the shape of cutting edge 25 dictates the direction and path along which bottom wall 15 will be cut by the piercing spike 23.

Furthermore, the Steidley patent teaches away from the a blunt tip. Instead, the Steidley patent discloses that piercing spike 23 cuts bottom wall 15 along a cutting edge 25. *See* column 2, lines 20-22; column 4, lines 17 *et seq.*; column 5, lines 12-31. Thus, the closure disclosed by the Steidley patent is not designed to be used with a blunt probe, it is designed to be used with a sharpened probe having a cutting edge.

Appellant respectfully submits that the claimed subject matter of claim 26 is in no way identical to the disclosed closure or spike of the Steidley patent. Appellant respectfully submits that the combination of claim 26 is indeed subject matter which Appellant regards as their invention. Appellant requests that the Board overturn and withdraw the Examiner's rejection of Claim 26 under 35 U.S.C. §112, second paragraph.

8.6 35 U.S.C. § 102(b) Rejection of Claims 1, 2, 5, 9, 15, and 16**8.6.1 Claims 1, 2, 5, 9, 15, and 16**

The Examiner has rejected claims 1, 2, 5, 9, 15, and 16 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,022,258 to Steidley. The Steidley fails to teach or suggest the cap of the present invention including a central well having at least one scoreline positioned on a bottom and a side wall formed to cause a probe having a blunt tip to engage the bottom at a center thereof as the probe is forced into said well. Furthermore, the Steidley patent fails to teach or suggest positioning the scoreline such that the blunt-tipped probe splits said bottom along said scoreline as the blunt tip of the probe is forced against the center of the bottom, as is called for by presently amended Claim 1.

The Steidley patent does not disclose such features. Instead, the Steidley patent discloses a closure 10 having a tubular sleeve 14 extending downwardly from a top wall 13 and a bottom wall 15 closing the lower end of sleeve 14. Bottom wall 15 has a dome-shaped upper surface which facilitates proper positioning and cutting action of a cooperating piercing spike that engages a perimeter of the bottom wall. *See* column 2, lines 20-22; FIGS. 2 and 3. The closure, and in particular, bottom wall 15 is formed to allow a piercing spike 23 to cut bottom wall 15. *See* column 2, lines 20-22; column 4, lines 17 *et seq.* In particular, piercing spike 23 slits bottom wall about almost the periphery of bottom wall 15. *See* column 5, lines 12-31. Since a cutting edge 25 of spike 23 is interrupted at a heel portion 27, piercing spike 23 forms a flap 36 which folds downwardly to make way for the descending spike. *Id.* Namely, dome-shaped bottom wall 15 properly positions an angular cutting edge 25 of spike 23 such that it pierces bottom wall

15 along its perimeter in a manner that results in the formation of a flap which is pushed aside but not detached from the closure. *See* column 2, lines 28-33.

In contrast, the cap of the present invention directs a blunt tip of a probe toward a center of a well bottom as it is forced into the well in order to split the well without the need for a cutting edge. *See* FIG. 5. In this regard, the claimed invention includes a well 46, a scoreline 51 positioned on a bottom 48 of the well, and a side wall, for example, conical side 47, which formed to cause a dispenser probe 61 having a blunt tip 62 to engage bottom 48 at a center thereof as probe 61 is forced into the well. Scoreline 51 is positioned such that blunt tip 62 of probe 61 splits bottom 48 along scoreline 51 as blunt tip 62 is forced against the center of bottom 48. *See* FIG. 5. The configuration of the well, in combination with the resiliency of the plastic cap, allows the well to substantially return to its original position when the bottle is removed from a water dispenser thus inhibiting spillage of any water remaining in the bottle. *See* column 5, lines 3-8.

For at least these reasons, Appellant respectfully submits that the Steidley patent does not anticipate presently amended claim 1. Appellant submits that claims 2, 5, 9, 15 and 16, which depend from claim 1, are allowable over the cited art for at least the same reasons noted above. Appellant requests that the Board overturn and withdraw the Examiner's rejection under 35 U.S.C. §102(b).

8.6.2 Claim 2

The Examiner has rejected claim 2 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,022,258 to Steidley. Appellant respectfully submits that the Steidley patent does not anticipate claim 2 for same reasons discussed above that the Steidley patent does not anticipate claim 1 above.

The Steidley patent also fails to teach or suggest a cap "made of resilient material whereby said well is restored substantially to initial condition when said probe is withdrawn from said well to inhibit spillage from said container neck", as is called for by claim 2.

Instead, the Steidley patent discloses a ported closure having a dome-shaped bottom wall 15 for properly positioning an angular cutting edge 25 of spike 23 such that it pierces bottom wall 15 along its perimeter in a manner that results in the formation of a flap which is pushed aside but not detached from the closure. *See* column 2, lines 28-33; column 5, lines 23-34; FIG. 3. Flap 36 is designed such that it is not released into the body of fluid within the container. *See* lines 23-34; FIG. 3. Steidley fails to teach or suggest that flap 36 will return to its original position when spike 23 is removed from the closure.

In contrast, an important feature of the cap of the present invention is that the well returns to its original position to considerably reduce spillage of any water which may remain in the bottom when the bottle is removed from a conventional water dispenser. *See* column 2, lines 46-50. The resiliency of the plastic cap allows the well to substantially return to its original condition thus preventing substantial leakage of the water onto the outside of the water dispenser and/or the floor. *See* column 5, lines 3-8.

For at least these reasons, Appellant respectfully submits that the Steidley patent does not anticipate claim 2. Appellant requests the Board to overturn and withdraw the Examiner's rejection of claim 2 under 35 U.S.C. §102(b).

8.6.3 Claim 5

The Examiner has rejected claim 5 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,022,258 to Steidley. Appellant respectfully submits that the Steidley patent does not anticipate claim 5 for same reasons discussed above that the Steidley patent does not anticipate claim 1 above.

The Steidley patent also fails to teach or suggest a cap of claim 5 which calls for, *inter alia*, a first screw thread and a second screw thread whereby said second screw thread expands to slip over said first screw thread when said cap is pushed axially downward on said neck without relative rotation of said cap and said neck.

The Steidley patent discloses a ported closure 10 having internal threads (unnumbered) and a bottle 16 having a threaded neck 16a. The Steidley patent, however, does not teach or suggest a cap which is pushed axially downward on the bottle without relative rotation therebetween.

In contrast, the cap of the present invention includes a thread 24 which expands and slips over thread 14, *see* column 4, lines 27-30, which configuration provides a push-on type cap. *See* column 2, lines 7-9.

For at least these reasons, Appellant respectfully submits that the Steidley patent does not anticipate claim 5. Appellant requests the Board to overturn and withdraw the Examiner's rejection of claim 5 under 35 U.S.C. §102(b).

8.6.3 Claim 15

The Examiner has rejected claim 15 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,022,258 to Steidley. Appellant respectfully submits that the Steidley patent does not anticipate claim 15 for same reasons discussed above that the Steidley patent does not anticipate claim 1 above.

The Steidley patent also fails to teach or suggest a cap of claim 15 which calls for, *inter alia*, a cap in which said side wall is conical.

Instead, the Steidley patent discloses closure 10 having a tubular sleeve 14 extending downwardly from a top wall 13 and a bottom wall 15 closing the lower end of sleeve 14. Bottom wall 15 has a dome-shaped upper surface which facilitates proper positioning and cutting action of a cooperating piercing spike that engages a perimeter of the bottom wall. *See* column 2, lines 20-22; FIGS. 2 and 3.

In contrast, the scope of claim 15 is directed to a cap having a conically shaped side wall which directs a blunt tip of a probe toward a center of a well bottom as it is forced into the well in order to split the well without the need for a cutting edge. *See* FIG. 5. In this regard, the cap includes conical side 47 which is formed to cause a dispenser probe 61 having a blunt tip 62 to engage bottom 48 at a center thereof as probe 61 is forced into the well. *See* FIG. 5.

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For at least these reasons, Appellant respectfully submits that the Steidley patent does not anticipate claim 15. Appellant requests the Board to overturn and withdraw the Examiner's rejection of claim 15 under 35 U.S.C. §102(b).

9.0 Conclusion

Appellant therefore respectfully requests the Board of Appeals to overturn and withdraw the Examiner's rejections.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extension of time or additional claims, and/or credit any overpayment to Deposit Account No. 06-1300 (Order No. RI-61182/RBC/VEJ).

Date: 4/1/02

Respectfully submitted,



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APPENDIX A
Appealed Claims

1. (Thrice Amended) A cap for use with a container neck having external means for detachably engaging said cap, said cap being shaped to fit over said neck and comprising

a top and a [shirt] skirt depending from said top to fit outside said neck, internal means on said skirt to engage said

external means to hold said cap on said neck, said top being formed with a central well having a side wall and a bottom, [a] at least one scoreline [extending along said side wall and across] positioned on said bottom, said side wall formed to cause [whereby] a probe having a blunt tip to engage said bottom at a center thereof as the probe is forced into said

well, said at least one scoreline positioned such that the blunt tip splits said [well] bottom along said scoreline as the blunt tip of the probe is forced against said center of said bottom so that said probe may enter said neck.
2. A cap according to claim 1 made of resilient material whereby said well is restored substantially to initial condi-

tion when said probe is withdrawn from said well to inhibit spillage from said container neck.

3. (Once Amended) A cap according to claim 1 which further comprises a gasket on the underside of said top to seal said cap to said [lip] neck.

4. A cap according to claim [4] 3 in which said gasket is of foam plastic.

5. (Once Amended) A cap according to claim 1 in which said cap is of a resilient plastic and said external means comprises a first screw thread and said internal means comprises a second screw thread whereby said second screw thread expands to slip over said first screw thread when said cap is pushed axially downward on said neck without relative rotation of said cap and said neck.

6. (Once Amended) A cap according to claim 5 for use with a container having first orientation means, said cap further comprising second orientation means [cooperable with said first orien-

tation means] whereby when said cap is pushed axially downward on said neck said first screw thread and said second screw thread are inter-engaged.

7. In combination a container neck and a cap according to claim 1 in which said external means comprises a crown bead and said internal means comprises a locking bead positioned to engage under said crown bead to prevent removal of said cap from said neck when said cap is intact.

8. (Once Amended) The combination of claim 7 which further comprises means for removing a portion of said [skirt containing said] locking bead to [prevent] allow removal of said cap from said neck.

9. A cap according to claim 1 in which said external means comprises a first screw thread and said internal means comprises a second screw thread.

10. A cap according to claim 9 wherein said neck has a lip, a cylindrical portion below said lip formed with said external first screw thread and a crown bead below said cylin-

drical portion, said first screw thread having [an] a thread end [formed as a ramp of reduced thickness],

said cap comprising a top and a skirt depending from

said top, said skirt having a restricted diameter cylindrical upper stretch formed with said internal second screw thread shaped and positioned to mate with said first screw thread, an enlarged diameter stretch below said upper stretch for engaging said crown bead and an internal locking bead for engaging the underside of said crown bead, and at least one barrier extending downward from said second screw thread, said at least one barrier being horizontally aligned with said [ramp] thread end when said cap is installed on said neck, whereby turning said cap relative to said neck in an unwinding direction causes said cap skirt to expand outward and said second screw thread to disengage from said first screw thread.

11. A cap according to claim 10 which further comprises a plurality of downward extending second barriers angularly spaced apart [and] from said first-mentioned barrier and depending from said screw thread.

12. A cap according to claim [1] 10 in which said skirt extends below said enlarged diameter stretch to a bottom edge, a tear tab extending below said bottom edge and a tear line formed in said skirt adjacent said tear tab extending up from said bottom edge to said upper stretch.

13. A cap according to claim 12 in which said tear line is substantially vertically disposed and which further comprises a second tear line approximately parallel to said first-mentioned tear line disposed on the side of said tear tab opposite said first mentioned tear line extending up from said bottom edge to said upper stretch.

14. A cap according to claim 12 which further comprises a plurality of angularly spaced apart guide ribs extending downward from said internal locking bead[, said guide ribs being triangular in vertical cross-section].

15. A cap according to claim 1 in which said side wall is conical.

16. A cap according to claim 15 in which said bottom is round.

17. A cap according to claim 16 in which said scoreline comprises a first stretch along said side wall, a second stretch across said bottom and a third stretch along said side wall, said stretches being joined end to end and lying in a common plane [substantially diametric relative to] containing the axis of said well.

18. (Once Amended) A cap according to claim [17] 1 which further comprises a short [external] rib on said bottom extending away from said scoreline whereby said probe when forced into said well first contacts said rib to initiate splitting said [well] bottom along said scoreline.

19. In combination, a container neck and a cap according to claim 1,

said container neck having a lip, a cylindrical portion

below said lip formed with said external first screw

thread and a crown bead below said cylindrical portion,

said first screw thread having an end formed as a ramp,

said cap having at least one barrier extending substantially

vertically downward relative to one of said screw threads into horizontal alignment with said ramp, said skirt being flexible, whereby turning said cap relative to said neck in an unwinding direction so long as said cap is intact causes said cap to expand outward and said screw threads to disengage from each other, and means to tear a portion of said skirt to release said cap from said neck.

20. The combination of claim 19 in which said at least one barrier is on said cap and extends downwardly from approximately 0° of angle of said second screw thread to approximately the elevation of 360° of angle of said second screw thread.

21. The combination according to claim 19 in which said cap is of resilient material whereby said well is restored substantially to initial condition when said probe is withdrawn from said well.

22. (Twice Amended) The combination of claim 19 in which said side [wail] wall is conical.

23. The combination of claim 22 in which said bottom is round.

24. (Once Amended) The combination of claim 23 in which said scoreline comprises a first stretch along said wall, a second stretch across said bottom and a third stretch along said side wall, said stretches forming a substantially continuous line in a plane [substantially diametric relative to] containing the axis of said well.

25. (Once Amended) The combination according to claim 24 which further comprises a short [external] rib on said bottom extending away from said second stretch.

26. (Once Amended) In combination, a hollow, apertured probe having a blunt tip, a cap, a container having a neck having external means for detachably engaging said cap, said cap being shaped to fit over said neck and comprising a top and a skirt depending from said top

internal means on said skirt to engage said

external means to hold said cap on said neck, said top

being formed with a central wall having a side wall and

a bottom, at least one scoreline positioned on said bottom,

said blunt tip engagable with said bottom to split said scoreline so

said probe may enter said container.

27. The combination of claim 26 in which said probe
seals against said well.

28. The combination of claim 27 wherein said probe seals against said sidewall.